

R E M A R K S:

The purpose of this amendment is to copy claims from issued U.S. Patent No. 4,182,767 dated January 8, 1980.

Claim 54 has been copied substantially from claim 6 of the reference patent and claim 55 has been copied substantially from claim 7 of the patent.

The subject matter involved is clearly supported in the above-identified application with respect to the compounds involved. Thus, the specification page 2 defines a structural formula in which R_3 is hydroxymethyl (page 2, line 24) and R_2 is hydrogen (page 2, line 24) and in which R_1 is alkyl (page 2, lines 11-15).

Note that the definition of R_1 is refined in the application at page 3, lines 20-21 to provide a most desirable range of 1 to 18 carbon atoms. Note that further refinement is found in claim 9 taken with the disclosure at page 3, lines 19-21.

With respect to the matter of the provision of compositions for antihyperglycemic use and composition which are so used, note that the application at page 46, lines 15 et seq refer to the inhibitors of the invention and note that they are inhibitors for treatment of diabetes (page 46, line 18) and that portion of the specification goes on to

provide a broad disclosure of pharmaceutical compositions which can be used for such purpose and furthermore, at page 51, line 29, et seq. provides a specified useful dose. Note that the manner of administration is further identified in the specification, page 52, lines 24 et seq. Corresponding disclosure is found in the German priority documents filed in this case along with translations of them. The documents are German Convention applications P 27 38 717.3 and P 27 58 025.2.

In the references made below, all are to the sworn translations of the Convention Documents which have already been made of record in this case in connection with pending interferences 100,397 and 100,398. Turning first to German P 27 38 717.3, note that in the structural formula on page 2 of that application, one finds depicted compounds wherein R_1 can be alkyl of 1 to 18 carbon atoms (page 3, line 1) and R_2 preferably represents hydrogen (or hydroxy) as is evident from that disclosure, page 5, lines 7-9. The antidiabetic use is found in the application at page 18, lines 16-19 and pharmaceutical compositions are clearly provided in the disclosure, page 18, lines 20 et seq with specific reference to dosage in the application at page 19, lines 30-31.

Similarly, German Convention Document P 27 58 025.2 provides the pertinent structural formula in its translation, page 2, wherein it is indicated that R_1 can be an aliphatic

hydrocarbon radical and that disclosure is refined on page 3, lines 18-19 with respect to R₁.

The definition of R₃ as hydroxymethyl is specifically provided for on page 2, lines 19-20 and, for instance, at page 3, line 1. The compounds are asserted to have antidiabetic utility in the translation, at page 39, lines 15-18 and the provision of various pharmaceutical forms is clearly provided for in the translation, page 40, lines 14 et seq with a specific dosage range provided in that translation at page 41, lines 9-11.

In view of the above, it seems clear that, with respect to the subject matter of added claims 54 and 55, applicants are entitled to a record date of August 27, 1977, the filing date of German P 27 38 717.3.

U.S. Patent 4, 182,767 was filed on May 10, 1978, a date subsequent to the record date of the German Priority Document of applicants, identified above. It is recognized that the Japanese filing dates (June 25, 1977) is prior to the record date of applicants. It is to be noted, however, that although Murai et al, the patentees, may have support in its U.S. application which matured into U.S. Patent 4,182,767 for the subject matter of its claims 6 and 7 (see, for example, that patent, column 1, line 63 through column 2, line 63), there is not one iota of disclosure to support such compositions or methods of treatment in the

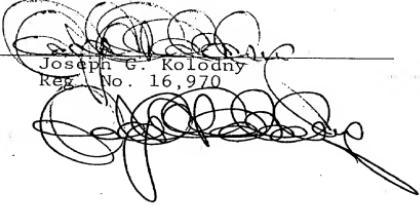
Japanese Convention Document. It seems clear, therefore, that Murai et al, U.S. Patent 4,182,767 is limited, with respect to its claims 6 and 7 to the filing date of its U.S. Application, a date subsequent to the one to which applicants are entitled. Under these circumstances, it seems clear that the declaration of an interference is warranted and in which ,applicants should be given the benefit of their German Priority Documents and made Senior Party.

Such action is most earnestly solicited.

Respectfully submitted,

SPRUNG, FELFE, HORN, LYNCH & KRAMER

By


Joseph G. Kolodny
Reg. No. 16,970

600 Third Avenue
New York, N.Y. 10016

(212) 661-0520

Fee Letter in duplicate.